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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/518,201	10/06/2005	Wei Huang	H0005631 68465 USA -4780	5242
128 7590 09/03/2010 HONEYWELL INTERNATIONAL INC. PATENT SERVICES 101 COLUMBIA ROAD P O BOX 2245 MORRISTOWN, NJ 07962-2245			EXAMINER YOON, TAE H	
			ART UNIT 1796	PAPER NUMBER
			MAIL DATE 09/03/2010	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/518,201

Applicant(s)

HUANG ET AL.

Examiner

Tae H. Yoon

Art Unit

1796

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-22, 24-27, 30-36, 41, 42, 47-49, 51-56, 76 and 77 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-22, 24, 25, 36, 41, 42, 47-49, 51, 52, 76 and 77 is/are rejected.
- 7) ☒ Claim(s) 26, 27, 30-35 and 53-56 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-840)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

The examiner left a telephone message on afternoon of August 27, 2010 with respect to the requested telephone interview, but has not received a return call as of this morning.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 18-22, 24, 25, 36, 41, 42, 47-49, 51, 52, 76 and 77 are rejected under 35 U.S.C. 103(a) as being unpatentable over FR 281602 in view of Hattori (US 6,165,676) and further in view of Miyamoto et al (US 6,808,857).

Furthermore, a first part of FR comprising all components (resol, surfactant, novolac with solvents of Hattori and Miyamoto et al) without a catalyst (second part) would be a *prima facie* obviousness.

Above rejection is maintained with following response.

Applicant asserts that the final product of FR includes a combination of said two-parts composition (a resin part and a catalyst part) and that FR neither teaches nor suggests one of these components could be utilized separately. Applicant further asserts that the office action is analogous to citing a motorcycle patent against a bicycle and saying that "the motorcycle without the motor/engine would be *prima facie* obviousness". But, the examiner disagrees with applicant for following reason.

1. The rejected claims are direct to a composition and a method of making said composition, not to a method of using or a final product thereof. Note that the final product (film and layered component) and a method of forming a film (claims 26, 27, 30-35 and 53-56) are not included in here. In fact, said claims 26, 27, 30-35 and 53-56 are objected in this office action.

2. FR teaches two-parts composition (a resin part and a catalyst part) and said first part (resin part) would be a *prima facie* obviousness since applicant's invention is directed to said first part (resin part). Claiming one part composition, which is either known or obvious, from either known or obvious two parts composition would not be patentable absent any unexpected result. Said first (resin part) of FR itself would form a film without a catalyst/curing agent and applicant failed to show it would not form a film.

3. Applicant's analogy, "the motorcycle without the motor/engine would [not] be *prima facie* obviousness" is not well taken since said motorcycle would be sold as one structure/part (the motorcycle has the motor/engine mount on it). In case it comes with two- parts, a body part (a structure having two wheels and a pedal as well as a body frame, handle bars and a seat) and an engine part, and then a bicycle comprising said body part only without the motor/engine part would be *prima facie* obviousness contrary to applicant's assertion.

The examiner doubts that the claim 18 with additional limitation to a solvent system such as "a solvent system consisting of solvents only" alone would overcome the rejection based on the above first part of FR.

Claims 18-21, 24, 25, 36, 41, 42, 47-49, 51, 52, 76 and 77 are rejected under 35 U.S.C. 103(a) as being unpatentable over FR 281602 in view of Drage (US 5,858,547) and further in view of Miyamoto et al (US 6,808,857).

Rejection is maintained for reason of record with above response.

Claims 26, 27, 30-35 and 53-56 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H. Yoon whose telephone number is (571) 272-1128. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Tae H Yoon/
Primary Examiner
Art Unit 1796

THY/September 1, 2010